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NOTES

ENTERTAINMENT TITLE DUPLICATION CASES: A PROCESS OF EVOLUTION*

With the advent of mass communication and mass distribution, an appealing title has become an absolute necessity in the entertainment field. The creation of road companies has enabled the "Broadway play" to travel to the medium sized communities and radio and television have enabled entertainment products to be delivered directly to the home. In order to compete successfully with other readily available entertainment products, each must be given a title that both immediately attracts the attention of the customer and is easy to remember. Moreover, if the title is popular in its own right, advertising the product to which it is attached will be easier and less expensive. Because of these factors the entertainment field frequently places a high monetary value on a title which embodies the proper characteristics.¹ Indeed, Warner Brothers recently paid an author \$200,000 for the movie rights of the best-selling book *Sex and the Single Girl*, yet, it appears that the book itself cannot be adapted as a movie script, and the author assumed no script writing duties under the contract.

According to a studio spokesman, what Warner's bought was not the book but simply its title. Current Hollywood economic theory holds that the safest bet is to put one's money into a "pretested property" that has a "presold audience," and a best-selling title is considered the safest guarantee of all.²

In view of the mass production techniques required by the seemingly insatiable entertainment appetite of modern America it is almost inevitable that there are numerous duplications of title, some intentional and some by chance. The newspapers recently reported that Miss Zsa Zsa

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1. For a discussion of some of the attributes of a desirable title in the entertainment field as well as a discussion of the most productive sources of such titles see Tannenbaum, *Copyright Law: Titles in the Entertainment Field*, 45 A.B.A.J. 459 (1959).

2. *Life*, March 1, 1963, p. 65. This appears to be the highest price paid for a title. For other sales and legal awards see Tannenbaum, *supra* note 1, at 459, 461; Klein, *Is Unauthorized Use of Titles of Artistic Works in Unrelated Fields Actionable Piracy*, 28 BROOKLYN L. REV. 59, 67 (1961).

Gabor was writing a book entitled *Bedtime Stories for Adults*, and that an Iowa minister had just published a book under the same title.³ One author states that an examination of the United States *Catalogue of Copyright Entries* shows "that title duplication is the rule rather than the exception."⁴

Since titles of entertainment products unquestionably have monetary value and because there are recurring instances of competing use of the same or substantially similar titles, the parties frequently find resort to the courts necessary for a determination of their respective rights. This note will examine the protection which is accorded through such litigation to those whose titles have been duplicated,⁵ with particular emphasis upon the evolutionary nature as well as the present status of the case law, and some tentative conclusions will be advanced about the future course of events in this area.⁶

3. Peterson, *Life Begins at Forty*, Indianapolis Star, March 10, 1963, p. 8, col. 1. Even more recently, reports appeared about the legal problems of Attorney General Robert F. Kennedy surrounding the title of his book *The Enemy Within*. A newspaper reporter, Irene Kuhn, apparently is suing Kennedy on the grounds that his sale of the movie rights to the title have unfairly interfered with the rights she acquired by use of the same title on a book written some ten years before the Attorney General's. Walter Winchell, *Broadway and Elsewhere*, Indianapolis Star, Sept. 29, 1963, sec. 2, p. 1, col. 1.

4. NICHOLSON, A MANUAL OF COPYRIGHT PRACTICE FOR WRITERS, PUBLISHERS, AND AGENTS 165 (2d ed. 1956). A "Title Report" prepared by a New York law firm shows no less than seventy-seven uses of the title *Backfire* for plays, motion pictures, radio, television and fiction works between 1913 and 1956. Netterville and Hirsch, *Piracy and Privilege in Literary Titles*, 32 So. CAL. L. REV. 101, 152-57 (1959).

5. The term "title duplication" is used as a convenient description of this type of case. It is not meant to infer that exact duplication is required. A title that is substantially the same or constitutes a colorable imitation will raise the same issues. See *National Picture, Inc. v. Foundation Film Corp.*, 266 Fed. 208 (2d Cir. 1920) (*Blindness of Youth v. Blind Youth*). See generally RESTATEMENT, TORTS, §§ 728-29 (1938).

6. Because substantially different questions are presented, no attempt will be made to analyze the protection afforded to a title which is used periodically, e.g., the titles of newspapers, magazines, etc. See generally 2 NIMS, THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS § 279 (4th ed. 1947); see, e.g., *HMH Publishing Co. v. Hale*, 156 F. Supp. 594 (N.D. Cal. 1957); *Time, Inc. v. Motor Publications, Inc.*, 131 F. Supp. 846 (D. Mass. 1955). Also, no attempt has been made to delineate the protection afforded a character. See generally 2 NIMS, *op. cit. supra*, § 280; Comment, *Literary Property in Characters: Protection Afforded Authors by Copyright and Unfair Competition*, 21 ALBANY L. REV. 185 (1957); see, e.g., *Lone Ranger, Inc. v. Cox*, 124 F.2d 650 (4th Cir. 1942); *Detective Comics v. Bruns Publications, Inc.*, 28 F. Supp. 399 (S.D.N.Y. 1939), *aff'd*, 111 F.2d 432 (2d Cir. 1940). Nor has any attempt been made to determine when an association in the entertainment field can prevent another group from using a confusingly similar name. See generally 1 NIMS, *op. cit. supra*, § 86; see, e.g., *Metropolitan Opera Ass'n v. Metropolitan Opera Ass'n of Chicago*, 81 F. Supp. 127 (N.D. Ill. 1948); *Duemling v. Fort Wayne Community Concerts, Inc.*, 188 N.E.2d 274 (Ind. 1963). The primary emphasis will be on the legal protection afforded the author or composer who has applied his title to a single literary effort. For a summary of the area of rights in the entertainment field see KAPLAN & BROWN, CASES ON COPYRIGHT, UNFAIR COMPETITION, AND OTHER TOPICS BEARING ON THE PROTECTION OF LITERARY, MUSICAL, AND ARTISTIC WORKS (1960).

I. STATUTORY NON-PROTECTION

A. Copyright

Pursuant to the enabling language of the Constitution,⁷ Congress has afforded to authors and composers a monopoly in their original works through the enactment of the copyright laws.⁸ However, it has been judicially settled since 1850 that this monopoly protection does not extend to the mere title of the work. In *Jollie v. Jaques*,⁹ the case which apparently established this principle, it was recognized that a title "is sometimes, doubtless, the source of as much profit as the intrinsic merit of the work itself."¹⁰ However, "the right secured [by the copyright law] is the property in the piece of music, the production of the mind and genius of the author, and not in the mere name given to the work. . . . The title is an appendage to the book or piece of music. . . ."¹¹ Not only have subsequent decisions consistently adhered to this rule,¹² but the most recent regulations of the Copyright Office specifically enumerate "names, titles, and slogans" as works which are not subject to copyright.¹³

B. Trademark

In the Lanham Act,¹⁴ Congress has attempted to continue its protection of trademarks against unfair or deceptive uses. Nevertheless, in the law of trademark as in the law of copyright, it has been judicially determined that entertainment titles do not fall within the protected area. The current view as to the registerability of such titles, or nonregisterability to be more precise, is represented by *In Re Cooper*.¹⁵

In 1953, Cooper's application for the registration of *Teeny-Big* as a trademark for children's books was refused by the Examiner of Trademarks, and the Assistant Commissioner affirmed the Examiner's position. Cooper then appealed to the United States Court of Customs and Patent Appeals.¹⁶ That court pointed out that the Lanham Act precludes

7. U.S. CONST. art. I, § 8, which reads in part: "The Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Rights to their respective Writings and Discoveries. . . ."

8. Copyright Act, 17 U.S.C. §§ 1-216 (1958), as amended, 17 U.S.C. § 9 (Supp. III, 1962).

9. 13 Fed. Cas. 910 (No. 7437) (C.C.S.D.N.Y. 1850).

10. *Id.* at 914.

11. *Ibid.*

12. See, e.g., *Glaser v. St. Elmo Co.*, 175 Fed. 276 (C.C.S.D.N.Y. 1909); *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P.2d 474 (Dist. Ct. App. 1947).

13. 37 C.F.R. § 202.1 (1960).

14. 60 Stat. 427 (1946), as amended, 15 U.S.C. §§ 1051-1127 (1958).

15. 45 C.C.P.A. (Patents) 923, 254 F.2d 611 (1958).

16. *Id.* at 925, 254 F.2d at 612.

the registration of a mark which merely describes the product to which it is affixed. Thus, while *Coca-Cola* or *Coke* could be registered to cover a carbonated beverage or soft drink, a request to register "carbonated beverage" or "soft drink" would be refused. In the field of literary endeavor, "however arbitrary, novel or nondescriptive of contents the name of a book—its title—may be, it nevertheless describes the book. . . . How else would you describe it—what else would you call it?"¹⁷ Thus, the title of a book, according to the court, serves the same function as the words "soft drink" as applied to a liquid; it merely serves as a description of one—the *Teeny-Big* books—among all the books in the world. It does not describe the particular book, *i.e.*, the *Teeny-Big* book with page thirty torn at the upper right-hand corner or the three thousandth *Teeny-Big* book to be printed. In explicating the policy behind the decision, Judge Rich noted that the monopoly rights afforded to literary property through the laws of copyright was for a limited duration, while trademark protection endured as long as the use continued.¹⁸ Thus, the court's refusal to grant registration was primarily the result of a judicial aversion to extending absolute protection to an author or composer's title.

The result of the *Jollie* and *Cooper* cases is that Congress, as the courts have interpreted the copyright and trademark laws, has not yet afforded statutory protection to titles. This may result, as the *Cooper* case implies, from what Professor Chafee has characterized as a policy against monopolies, particularly in the field of ideas.¹⁹ Consequently, the

17. *Id.* at 929, 254 F.2d at 615. The court went on to point out that the name of a series of books containing the same central character, etc., could be registered since it served the same function as the name of a periodical or newspaper, *Ibid.*

18. *Id.* at 930, 254 F.2d at 615. Cf. *Atlas Mfg. Co. v. Street & Smith*, 204 Fed. 398 (8th Cir. 1913); *Black v. Ehrich*, 44 Fed. 793 (C.C.S.D.N.Y. 1891); *Crown Publishers, Inc. v. David McKay Co.*, 200 Misc. 905, 107 N.Y.S.2d 176 (Sup. Ct. 1951). The court, in the *Cooper* case, appears to say that all items can be placed on a descending scale of sub-classifications and the rank on this scale will automatically determine its status as a potential trademark. Thus, if *Teeny-Big* had corresponded with *Coke* on this scale, it could have been registered. It might have been interesting if the court had attempted to define the levels of this scale, because the only limits to the number of sub-classes are the limits of one's imagination. If the scale starts with matter as the first class, common to both *Teeny-Big* and *Coke*, it could descend to foods and artistic endeavors, then to liquid foods and literary artistic endeavors, then to soft drink liquid foods and book-type literary artistic endeavors, and finally to *Coke* as a soft drink liquid food and *Teeny-Big* as a book-type literary artistic endeavor. Using this scale, *Teeny-Big* becomes the proper subject for registration. This merely serves to point up the absurdity of any arbitrary scale system to determine registration applications. Perhaps the court would have presented a more palatable decision if it had based it on a more firm foundation, or even stressed the desirability of limiting monopolization in the area of words and ideas.

19. Chafee, *Unfair Competition*, 53 HARV. L. REV. 1289, 1317-18 (1940). See also Callman, *Unfair Competition in Ideas and Titles*, 42 CALIF. L. REV. 77 (1954). For a survey of the statutory protection afforded in other countries from Albania to Yugoslavia see IV PINNER, *WORLD COPYRIGHT* 254-83 (1958).

total absence of statutory protection has rendered the common law of unfair competition the principal source of an author's or composer's protection.

II. UNFAIR COMPETITION

American courts in early title duplication cases, while denying recovery under the copyright law, consistently refused to exclude legal protection under all doctrines if the proper fact situation was presented.²⁰ The case of *G. & C. Merriam Co. v. Ogilvie*²¹ presented such a situation. After the Merriam Company's copyright on the *Webster Dictionary* expired, the defendant began publishing a copy of the Merriam dictionary and used the title *Webster* in such a way as to make it appear to be one of the plaintiff's products. The court, while holding that the defendant was entitled to use the name *Webster* because that title had entered the public domain when the company's copyright on the dictionary expired, stated that such use was subject to the law of unfair competition.²² This doctrine has continued to be the primary source of protection in subsequent title duplication cases.²³

A. Some Preliminary Problems

1. Wide Discretion

The extent of the doctrine of unfair competition defies delineation because of its "plastic" nature.²⁴ It has, however, been generally stated that:

[T]he law relating to unfair trade has a three-fold object: First, to protect the honest trader in the business which fairly belongs to him; second, to punish the dishonest trader, who is taking his competitor's business away by unfair means; third, to protect the public from deception.²⁵

Since the doctrine is invoked on essentially equitable grounds there is a great deal of discretion vested in the judge, and it is applied only when

20. See, e.g., *Benn v. Leclercq*, 3 Fed. Cas. 201, 202 (No. 1308) (C.C.D. Mass. 1873); *Jollie v. Jaques*, 13 Fed. Cas. 910, 914 (No. 7437) (C.C.S.D.N.Y. 1850).

21. 159 Fed. 638 (1st Cir. 1908).

22. *Id.* at 640-41. If, as *Jollie v. Jaques* indicates, the copyright laws do not extend to the title, they offered no protection for the *Webster* name even before the copyright expired. However, copying the contents was unlawful prior to the expiration.

23. See, e.g., *National Picture Theatres, Inc. v. Foundation Film Corp.*, 266 Fed. 208 (2d Cir. 1920); *Atlas Mfg. Co. v. Street & Smith*, 204 Fed. 398 (8th Cir. 1913); *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934); *Paramore v. Mack Sennett, Inc.*, 9 F.2d 66 (S.D. Cal. 1925).

24. See *Ely-Norris Safe Co. v. Mosler Safe Co.*, 7 F.2d 603, 604 (2d Cir. 1925) (L. Hand, J.).

25. *Atlas Mfg. Co. v. Street & Smith*, 204 Fed. 398, 405 (8th Cir. 1913).

his sense of justice indicates that a certain undefined standard of business activity has been violated. The applications of the doctrine to particular fact situations frequently appear to be inconsistent because of the varying economic predilections of the judges.²⁶

2. Necessity for Underlying Copyright

A question which has frequently been presented to the courts and never clearly answered is whether an author or composer has any right in a title to a work which was never copyrighted or on which the copyright has expired. The notion was advanced in a number of earlier cases that if the work in question was not registered under, and hence was unprotected by, the copyright law, its title would similarly be accorded no protection.²⁷ However, such pronouncements were not directed to the protection which might be afforded by the doctrine of unfair competition, for they are to be found in cases decided before the scope of that doctrine's application to title duplication cases had been fully established. The distinction which should be drawn was clearly pointed out by then Judge Cardozo:

If the copyright does not exist, or, once existing, has been lost, the name is lost, too, in so far as it is merely a symbol descriptive of the copyrighted thing. . . . We are not to confuse such situations with others which, superficially similar, are fundamentally distinct. A name which has become descriptive of one play may not be attached by a competitor to another when the duplication will mislead the public into the belief that the two performances are alike. . . . So a name which is associated in common thought, not merely with the thing produced, but with the source or origin of production, may not be used, though the term of copyright . . . has expired, without explanation adequate to guard against mistake.²⁸

This view is the more desirable since the purpose of the doctrine of unfair competition²⁹ is not related to the statutory monopoly granted under the copyright law, but owes its existence rather to the ethical standards of certain competitive activities. When a title has acquired the inde-

26. Tannenbaum, *supra* note 1, at 460.

27. See, *e.g.*, *Glazer v. St. Elmo Co.*, 175 Fed. 276, 278 (C.C.S.D.N.Y. 1909); *Harper v. Ranous*, 67 Fed. 904, 905 (C.C.S.D.N.Y. 1895); *Jollie v. Jaques*, 13 Fed. Cas. 910, 914 (No. 7437) (C.C.S.D.N.Y. 1850).

28. *Underhill v. Schenck*, 238 N.Y. 7, 20, 143 N.E. 773, 778 (1924). *Accord*, *G. & C. Merriam Co. v. Ogilvie*, 159 Fed. 638, 640 (1st Cir. 1908); *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196, 197 (S.D.N.Y. 1934).

29. See text accompanying note 25, *supra*.

pendent descriptive quality referred to by Judge Cardozo, usually denoted as secondary meaning,³⁰ the common law doctrine should afford protection without regard to the presence or absence of an underlying copyright on the work itself.

3. Federal v. State Law

A serious jurisdictional problem is created, however, by adoption of the view that the unfair competition doctrine is not dependent on an underlying copyright. The federal courts have exclusive jurisdiction in all cases arising under the copyright laws.³¹ This permits the development and application of a unified body of federal law in all copyright cases. However, unfair competition, being a common-law doctrine, presents no federal question, and a suit based solely on such an allegation may be brought in a state court which will apply state law.³² Of course plaintiff can proceed in a federal court where either diversity of citizenship is present or a claim of unfair competition is joined with a "substantial and related" claim under the copyright law,³³ but under *Erie R.R. v. Tompkins*,³⁴ the federal courts must nevertheless apply the state law of unfair competition to the dispute. Such a result not only presents some obvious yet complicated conflict of laws problems in this age of widespread distribution of entertainment products, but also promotes a fragmentation of the law of unfair competition; there could conceivably be fifty different views on the protection afforded titles under the doctrine as each state develops its own body of case and statutory law.³⁵

This fragmentation of the law of unfair competition, coupled with the wide discretion vested in courts to determine its applicability to a particular set of facts, makes any attempt to concisely set forth the law in this area impossible. Nevertheless, it is possible to arrive at some general conclusions about what type of activity will likely demand an invocation of the doctrine, and to formulate some tentative standards which courts will employ, regardless of the fact situation, to determine violations of the applicable law of unfair competition.

B. *The Theories of Protection*

One basic requirement in any suit for unfair competition is that the plaintiff be the owner of the right for which he claims protection, and

30. This quality of "secondary meaning" will be discussed *infra*.

31. 28 U.S.C. § 1338(a) (1958).

32. *Corbett v. Purdy*, 80 Fed. 901 (C.C.S.D.N.Y. 1897).

33. 28 U.S.C. § 1338(b) (1958).

34. 304 U.S. 64 (1938).

35. For a criticism of this fragmentation of the law of unfair competition see Chafee, *supra* note 19, at 1299-1301. See also KAPLAN & BROWN, *op. cit. supra* note 6, at 493-94.

that the defendant have claimed or exercised that right.³⁶ But beyond this elementary idea, what theory of protection is available to a plaintiff in such an action? The recent case of *McGraw-Hill Book Co. v. Random House, Inc.*,³⁷ appears to have established the broadest protection presently available in any jurisdiction. The court there stated that the plaintiff need only show either: (a) a likelihood that the public will confuse the *product* of the defendant for that of the plaintiff, (b) a likelihood that the public will be misled as to the *source* of the defendant's product, believing it to be produced or sponsored by the plaintiff or (c) a likelihood that a *dilution* in the distinctiveness of the plaintiff's title will occur in the mind of the public because of the similarity of the defendant's title.³⁸ Because each of these theories has been accepted to a degree in one jurisdiction or another, they merit individual consideration here.

1. Confusion of Products

Americans live by symbols.³⁹ They purchase a product without careful inspection simply because of the brand-name appearing on it, the name being taken by the consumer as a guarantee of craftsmanship from the manufacturer to himself. When a second manufacturer places the same brand-name on his similar product, the public is quite apt to rely on the symbol alone and purchase the goods, believing them to be those of the first manufacturer. The natural result of such practices is that the public is deceived and the original user of the name deprived of a potential sale. Moreover, if the products of the second manufacturer are of inferior quality the public is also damaged in a monetary sense, and the reputation for quality of the original user of the name consequently suffers injury. To prevent fraud of this nature, the law of unfair competition prohibits the use of a mark or name by one person or concern which the public associates with the goods of another, and this proscription applies to titles used in the entertainment field just as it does to titles or brand-names used by "producers" in other segments of the economy.

36. See, e.g., *Franklin v. Hart*, 129 F. Supp. 222 (S.D.N.Y. 1955), where the plaintiffs, composers of the song *Anniversary Waltz*, were seeking to enjoin the producers of a similarly titled play from licensing or selling the movie rights to the title. The court denied relief since the defendants had only purchased the play rights from the author of a similarly titled play. The author had retained all other rights in the play. Thus, the defendants had no rights to convey to a motion picture concern, and the court rightly refused to enjoin them from doing so.

37. 32 Misc. 2d 704, 710-711, 225 N.Y.S.2d 646, 653-54 (Sup. Ct. 1962).

38. This last area was included in the case as being within N.Y. GEN. BUS. LAW § 368(d), but will be covered in the text discussion as an evolving part of the law of unfair competition, independent of any statutory provision.

39. See *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (Frankfurter, J.).

Initially, the plaintiff seeking to establish his right through the laws of unfair competition to the exclusive use of a title encountered appreciable difficulty, for judicial relief depended on whether or not members of the public had actually been deceived by the defendant's practices.⁴⁰ Later cases dispensed with this requirement of actual deception, and granted relief where the defendant clearly intended to deceive the public, and where the duplication was so similar as to make deception likely.⁴¹ The present view in this areas, however, is that the element of intent will be inferred where product confusion is an inevitable consequence of the defendant's conduct.⁴² Thus, if the defendant has applied a duplicate title to the same type of product as that of the plaintiff in such a manner that the public is likely to be deceived, the courts will generally grant a remedy without regard to the former's actual intent. This leaves unanswered, however, the question of what is a "similar product."

The early cases afforded protection in duplication disputes only where the litigants' products were of such a nature as to make it likely that the public would mistake one for the other. The then prevailing rule, as stated by the Court of Appeals for the Eighth Circuit in *Atlas Mfg. Co. v. Street & Smith*,⁴³ required that the plaintiff have used his title on the same class, but not necessarily the same species, of goods as had the defendant. Consequently, while the court in *Atlas* admitted *arguendo* that the defendant's motion picture which used the name *Nick Carter* as part of the title might be drawing on the good-will of the plaintiff's series of books published under generally the same name, the court held that motion pictures and books were not competing products.⁴⁴ Yet

40. *Osgood v. Allen*, 18 Fed. Cas. 871, 876 (No. 10603) (C.C.D. Me. 1872).

41. *E.g.*, *Estes v. Williams*, 21 Fed. 189 (C.C.S.D.N.Y. 1884); *Golenpaul v. Rosett*, 174 Misc. 114, 18 N.Y.S.2d 889 (Sup. Ct. 1940); *Frohman v. Payton*, 34 Misc. 275, 68 N.Y. Supp. 849 (Sup. Ct. 1901).

42. *National Picture Theatres, Inc. v. Foundation Film Corp.*, 266 Fed. 208, 211 (2d Cir. 1920). See also *G. & C. Merriam Co. v. Ogilvie*, 159 Fed. 638 (1st Cir. 1908); *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal.2d 116, 222 P.2d 433 (1950); *Hopkins Amusement Co. v. Frohman*, 202 Ill. 541, 67 N.E. 391 (1903). *But cf.* *Walt Disney Prod., Inc. v. Souvaine Selective Pictures, Inc.*, 98 F. Supp. 774 (S.D.N.Y. 1951), in which the defendant produced and proposed to release his movie *Alice in Wonderland* at about the same time and in the same city as the Disney production of the same name. Although the intent to take advantage of the plaintiff's extensive advertising could easily have been inferred, the court denied an injunction and added "This is the sort of competition that perhaps should be encouraged rather than suppressed." *Id.* at 775. The case is distinguishable, however, since the plaintiff had not yet released his picture, making it impossible, in the eyes of the court, for the title to have acquired a secondary meaning. See note 81, *infra*.

43. 204 Fed. 398, 406 (8th Cir. 1913).

44. *Ibid.* This case appears clearly within the scope of confusion of source or sponsorship, to be considered later. See also *Day v. Twentieth Century Fox, Ltd.*, [1940] A.C. 112, 126 (Ont.), where the court refused to permit recovery by the owners of the copyrighted song *The Man Who Broke the Bank at Monte Carlo* from the pro-

another court, strictly adhering to the competing products requirement by stating that "there must be a real present or prospective competition, that is an endeavor to get the same trade from the same people at the same time,"⁴⁵ found nonetheless that the defendant's motion picture *Blindness of Youth* was of the same class as the plaintiff's play, *Blind Youth*. Viewing the facts of these cases, the distinction between which products compete and which do not may, perhaps, depend on the manner in which they are presented to the audience or consumer. Direct competition was found to be present between a play and a movie, both of which are presented in a theatre to live audiences. The necessary competitive element was held to be lacking, however, between a movie and a series of books, since those intending to purchase the book could hardly be confused enough by mere title similarity to buy a ticket for the movie.

2. Confusion of Source or Sponsorship

The end of strict judicial adherence to the competition rule in title duplication cases was foreshadowed by a decision outside the entertainment field in 1925. In *Wall v. Rolls-Royce of America, Inc.*,⁴⁶ the American division of the internationally famous manufacturer of airplanes and automobiles initiated suit against a manufacturer of radio tubes to enjoin its use of the name *Rolls-Royce*. Without distinguishing the theories of product confusion, confusion of source or sponsorship, or dilution, the court enjoined the defendant's use of the name. Since there is little likelihood that a person would mistake a radio tube for either an airplane or an automobile, the decision acknowledged, albeit *sub silentio*, that there could be an action for unfair competition absent the element of direct competition.⁴⁷ The court particularly emphasized that as both automobiles and radio tubes involve the use of electrical energy the public might reasonably infer that the defendant's tubes were produced

ducers of a motion picture of the same name. In holding these to be non-competing products, the court said, "A frying pan cannot be passed off as a kettle." But cf. *Frohmman v. William Morris, Inc.*, 68 Misc. 461, 123 N.Y. Supp. 1090 (Sup. Ct. 1910), where the court held that the burlesque *Chanticleer* unfairly competed with the serious play *Chanticleer* and added:

. . . doubtless true that no one intending to witness the plaintiff's play could possibly mistake the defendant's performance for it. But this power to distinguish would not save the playgoer who had gotten into the wrong theatre. His money would have been paid and his evening would have been irretrievably lost. . . .

Id. at 464, 123 N.Y. Supp. at 1092.

45. *National Picture Theatres, Inc. v. Foundation Film Corp.*, 266 Fed. 208, 211 (2d Cir. 1920).

46. 4 F.2d 333 (3d Cir. 1925).

47. See also *Triangle Publications, Inc. v. Rohrlisch*, 167 F.2d 969 (2d Cir. 1948) (magazines v. girdles); *Alfred Dunhill of London, Inc. v. Dunhill Shirt Shops, Inc.*, 3 F. Supp. 487 (S.D.N.Y. 1929) (smoking supplies v. shirts).

by a division of the famous company. Hence, if the tubes were of inferior quality, the excellent reputation currently enjoyed by the plaintiff would be impaired. Furthermore, the court continued, the defendant's creditors might attribute to the defendant a great deal more financial responsibility than he actually possessed if they associated his endeavors with those of the plaintiff company.⁴⁸

This same line of reasoning was declared applicable to the entertainment field in *Affiliated Enterprises, Inc. v. Rock-Ola Mfg. Corp.*,⁴⁹ where the court, in delineating the developing theory of unfair competition which will be referred to as confusion of source or sponsorship, stated:

In this day of expanding business activity . . . where large corporations produce and sell a variety of unrelated products upon which they often place a single trademark, it would be obviously unjust and ineffective to adhere to the old doctrine that unfair trade practices can only be enjoined in cases where actual competition exists between the parties.⁵⁰

The court in *Rock-Ola* ultimately determined that, under the facts presented, the plaintiff was not entitled to the protection of the unfair competition doctrine because the litigant's products were unconnected commercially.⁵¹ But it nonetheless injected the source or sponsorship theory

48. *Wall v. Rolls-Royce of America, Inc.*, 4 F.2d 333, 334 (3d Cir. 1925).

49. 23 F. Supp. 3 (N.D. Ill. 1937).

50. *Id.* at 8-9.

51. The court denied an injunction in this case because the plaintiff's copyright covered the printed instructions for playing the game *Bank Night*, while the defendant used the name *Big Bank Night* on some of its pin-ball machines. Not only was direct competition absent, but the products were so unrelated that the public was not likely to connect the defendant's machines with the plaintiff's company. See also *Becker v. Loew's, Inc.*, 133 F.2d 889, 893 (7th Cir. 1943), where the court stated that the public was not likely to confuse the defendant's romantic screen play *We Who Are Young* as in any way being connected with the plaintiff's book of the same title which was a discussion of economic and political problems during the New Deal. See also *Gotham Music Serv., Inc. v. Denton & Haskins Music Publishing Co.*, 259 N.Y. 86, 181 N.E. 57 (1932), where the plaintiff had revived the uncopyrighted song *Gambler's Blues* under the title *St. James Infirmary*. After an extensive advertising campaign, the song became a hit, and the defendant published a version under the title *St. James Infirmary or Gambler's Blues* so as to pick up all customers. The court denied an injunction saying that since the public had no idea who published any particular song, there was no chance of the public trying to buy the plaintiff's product and getting the defendant's. The source, according to the court, plays no part in this type of purchase so there couldn't be any confusion of source. A strong dissent by Justice Crane said the defendant's refusal to sell the song under its old title clearly demonstrated his unfair intent to capitalize on what the plaintiff's energy had turned into a valuable property. *Id.* at 93, 181 N.E. at 59. But cf. *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*, 157 F. Supp. 621 (S.D.N.Y. 1958) (preliminary injunction), where the plaintiff, the owner of a successful television series sued to enjoin its former licensee from continuing to use the Wyatt Earp name in connection with its children's playsuits. The court, in granting relief, said "The finding is nearly inescapable that the commercial value now enjoyed by the name is attributable

into the entertainment field, and there it remains today.⁵²

3. Dilution⁵³

If the confusion of source or sponsorship theory seems far removed from the general notion of unfair competition because it eliminates the necessity of direct competition, the concept of dilution must appear as a completely separate branch of the law. Not only is there no direct competition requirement, but the plaintiff needn't even show confusion on the part of the public; neither the plaintiff nor his product need be mentally associated with the defendant or his product by the general public.

The dilution theory essentially protects the right to the distinctive advertising appeal of a name or title which the public has grown to associate with the plaintiff. For example, the name *Rolls-Royce* is its own advertisement because of the widespread public recognition of that name as symbolic of a quality product. The company could merely paste the name on an otherwise blank billboard and a message of expert craftsmanship would be conveyed to most persons who observe it. What would happen, however, if an ice cream manufacturer labeled his product with this same name, and advertised extensively in connection with his product? There is clearly no competition between automobiles and ice cream, so the confusion of product theory would be unavailable to *Rolls-Royce*. Moreover, few members of the public would imagine that the original

almost entirely to the program." *Id.* at 624. The court, however, went on to point out that because of the well recognized practice of licensing the name of successful television heroes, subject to quality control standards, there was an actual likelihood of confusion of sponsorship and potential injury to the plaintiff's reputation. Also, there was an element of direct competition since any sales by the defendant decreased the royalties due the plaintiff from its licensee who sold playsuits. *Id.* at 626. This, however, seems to jump over the question of whether the plaintiff's rights in the title included the right to grant licenses and exclude non-licensed users of the name. It is important to note, however, that a recognized and frequently utilized trade practice may lead to an extension of the area of protection. On this point see also, *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 802, 187 P.2d 474, 487 (Dist. Ct. App. 1947), where the court noted that the purchase of a right to use a title, wholly divorced of any interest in the material, was a frequent transaction in the movie industry. In recognizing this as a legally protectable transaction, the court said, "We should be realistic." *But see*, *Golenpaul v. Rosett*, 174 Misc. 114, 117, 18 N.Y.S.2d 889, 893 (Sup. Ct. 1940), where the court, adhering to the traditional view, said, ". . . a trade-mark right is not a right in gross. . . ."

52. *E.g.*, *Time, Inc. v. Motor Publications, Inc.*, 131 F. Supp. 846 (D. Md. 1955); *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 222 P.2d 433 (1950). *But cf.* *Crown Publishers, Inc. v. David McKay Co.*, 200 Misc. 905, 107 N.Y.S.2d 176 (Sup. Ct. 1951), where the court held that in the case of books, the public buys as much because of the author's name as because of the title.

53. For an extensive discussion of dilution and a summary of the statutory and case law see, 3 CALMAN, *THE LAW OF UNFAIR COMPETITION AND TRADEMARKS* §§ 84.2-84.2(b) (2d ed. 1950); Derenburg, *The Problem of Trademark Dilution and the Anti-dilution Statutes*, 44 CALIF. L. REV. 439 (1956).

user of the name had diversified his product line to the extreme of producing ice cream, so the confusion of source or sponsorship theory would also have little application to the case. Hence, a billboard with just the name *Rolls-Royce* on it would now mean automobiles or ice cream, and as the number of manufacturers and producers employing that name continued to increase, the unique image formerly enjoyed by its originator would diminish. At some point, the name could become so commonly used that it no longer would have a secondary meaning in reference to automobiles, and the original user would not even be entitled to its exclusive use within his own product line.⁵⁴

A case which highlights the dilution theory is *Tiffany & Co. v. Tiffany Productions, Inc.*,⁵⁵ in which the famous jewelry firm sued to enjoin the defendant's use of the name *Tiffany* in its business of producing and distributing motion pictures. The defendant had coupled the use of a diamond design and phrases such as "Tiffany, It's a Gem," "Controlled by Tiffany," etc., with use of the name itself and evidently its purpose in doing so was partially accomplished, for there was testimony at trial that some members of the public did think that the plaintiff might be connected with the defendant's operations. The court issued an injunction in order to prevent this typical confusion of source or sponsorship, but went outside the facts to add: "The real injury in such cases of non-competitive products 'is the gradual whittling away or dispersion of the identity and hold upon the public mind of the mark or name by its use upon non-competitive goods.'"⁵⁶

54. An interesting example of this in the entertainment field may be drawn from a pair of New York cases before the turn of the century. Munro wrote a series of detective books between 1872 and the date of the trials, employing the words *Old Sleuth* in all of the titles. The series was a large success, and the imitators started to work. In *Munro v. Beadle*, 55 Hun 312, 8 N.Y. Supp. 414, 415 (Sup. Ct. 1890), the defendant had used the word *Sleuth* in connection with detective novels. In holding for the plaintiff, the court pointed out that the word *Sleuth* did not appear in the dictionary until after 1880, and even then applied only to a track in the snow or earth. The plaintiff's use in connection with a detective was novel and should be protected from infringing competitors. *Id.*, 8 N.Y. Supp. at 415. Some twenty-three months later, however, the Court of Appeals, in *Monro v. Tousey*, 129 N.Y. 38, 29 N.E. 9 (1891), decided that the same plaintiff could not enjoin the use of the name *Young Sleuth* in connection with competing detective novels. According to the court, no one seeking to read about that famous detective *Old Sleuth* could be deceived by the defendant's book. The court completely ignored the novelty of associating the word *Sleuth* with a detective. This may support the inference that the public in general associated the word with detectives rather than with the plaintiff's novels. If this is correct, the novelty of the plaintiff's original use had indeed suffered a dilution in the intervening twenty-three months.

55. 147 Misc. 679, 264 N.Y. Supp. 459 (Sup. Ct. 1932), *aff'd.*, 262 N.Y. 482, 188 N.E. 30 (1932).

56. *Id.* at 681, 264 N.Y. Supp. at 462. Callman indicates that this language shows acceptance of the dilution theory, and criticizes the court for finding it expedient to defend the decision under the confusion theory. 3 CALLMAN, *op. cit. supra* note 53, § 84.2(a).

The dilution theory has been accepted expressly in at least one title duplication suit in the entertainment field, *Johnston v. Twentieth Century-Fox Film Corp.*,⁵⁷ where the court said:

The law is not quiescent. It progresses. Evolution of the law to meet changing conditions is exemplified by the attitude of our [California] Supreme Court. The earlier cases held that . . . a showing had to be made that the name was being used by an infringer in a competing business. [But, subsequent cases have] . . . held that an injunction should issue even though the infringer was using the name in a non-competing business. The reasoning of the later cases is that use by another of a name or title results in a dilution of its value to the original appropriator.⁵⁸

Because the court found that the title of the plaintiff's book, *Queen of the Flat Tops*, was both novel and widely known, and in view of the widespread practice of authors selling the movie rights to their popular books, this case could have been decided on the confusion of source or sponsorship theory. The public would be likely to believe that the defendant's movie was a mere adaptation of the plaintiff's novel. Hence, there was no need to rely on the dilution theory, much less to base such reliance on the dicta of the *Tiffany* case.⁵⁹ *Communis error facit jus*.

In summary, there are three theories of unfair competition upon which a plaintiff may rely to establish his right to judicial relief when a title he has devised, having acquired a secondary meaning, is appropriated by another: (1) confusion of product, (2) confusion of source or sponsorship and (3) dilution. The theories have been accepted to varying degrees in the different jurisdictions, and only reference to the case law of a particular jurisdiction will indicate which have been judicially recognized there. However, recovery under any theory requires proof that a secondary meaning has been acquired. Consequently, delineation of those elements commonly considered in ascertaining whether a secondary meaning has attached to a product and been retained is necessary.

57. 82 Cal. App. 2d 796, 187 P.2d 474 (Dist. Ct. App. 1947).

58. *Id.*, 187 P.2d at 487, citing *Tiffany & Co. v. Tiffany Productions Inc.*, 147 Misc. 679, 264 N.Y. Supp. 459 (Sup. Ct.), *aff'd.*, 262 N.Y. 482, 188 N.E. 30 (1932).

59. Callman indicates that where there is an intentional appropriation of a widely accepted name, the courts presently afford protection even where there is little likelihood of confusion. He approves this acceptance of the protection of the dilution theory, but he severely criticizes the courts for the verbal contortions they usually engage in in order to demonstrate that they are adhering to the conventional confusion theories rather than embracing the new "heresy" of dilution. 3 CALLMAN, *op. cit. supra* note 53, § 84.2(a).

C. Secondary Meaning

"'Secondary Meaning' is *association*, nothing more. It exists only in the minds of those who identify some article of commerce or some business house by some name or sign and associate the two in their minds."⁶⁰ While the existence of secondary meaning in a work or title is ordinarily a question of fact,⁶¹ there are some elements of an entertainment title which can be singled out as particularly influential upon a court faced with the determination of that issue. This section is not, and could not be, designed to define secondary meaning. This is, and probably will remain, a question entirely related to the particular facts of each case. The section is, however, designed to present some tentative and admittedly broad standards which have been gleaned from the cases that may be helpful in analyzing individual situations.

1. Priority of Use

If the plaintiff is the first person to use a particular word or title he is in a position to argue that any meaning the title or word has acquired in the mind of the public is derived from his use. However, it is not unreasonable to state that most titles selected for entertainment products today have been employed by others at some time in the past.⁶² The courts have not authoritatively settled the problem of what effect such prior use has on an individual's right to monopolize a title.

In denying protection for the book title *Test Pilot*, one court referred to the fact that there were at least three prior users of this title. While the decision was based on other grounds, the court evidenced a strong doubt that a secondary meaning could be acquired by the plaintiff unless he were the first user of the title.⁶³ Other cases, however, indicate that the plaintiff need only be the first user of the title on the particular class of goods involved,⁶⁴ which of course again raises the question of what goods are members of the same class.⁶⁵ Still another court has stated

60. I NIMS, THE LAW OF UNFAIR COMPETITION AND TRADE-MARKS § 37. See also *Becker v. Loew's, Inc.*, 133 F.2d 889 (7th Cir. 1943).

61. See, e.g., *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal.2d 116, 222 P.2d 433, 437 (1950); RESTATEMENT, TORTS § 716, comment *b* at 560 (1938).

62. See text accompanying note 4, *supra*.

63. *Collins v. Metro-Goldwyn Pictures Corp.*, 25 F. Supp. 781, 784 (S.D.N.Y. 1938), *rev'd. on other grounds*, 106 F.2d 83 (2d Cir. 1939).

64. E.g., *Manners v. Triangle Film Corp.*, 244 Fed. 293, 295, *rev'd. on other grounds*, 247 Fed. 301 (2d Cir. 1917); *Clode v. Charles Scribner's Sons*, 200 App. Div. 532, 533, 193 N.Y. Supp. 176, 177 (1922).

65. See text accompanying notes 43-45, *supra*. In *Selig Polyscope Co. v. Unicorn Film Serv. Corp.*, 163 N.Y. Supp. 62 (Sup. Ct. 1917), *aff'd.*, 183 App. Div. 882, 169 N.Y. Supp. 1113 (1918), the court found that the prior use by third parties as a song title and a book title did not prevent the plaintiff from acquiring a secondary meaning in the play *The Rosary*.

that while the prior users would be entitled to continue their use of the title, their existence would not prevent another from establishing a secondary meaning and then being able to exclude later users.⁶⁶ Thus, the courts have held: (1) any prior use precludes the acquisition of a secondary meaning, (2) prior users will be permitted to continue, but if the plaintiff establishes his secondary meaning he may enjoin subsequent users and (3) if the plaintiff is the first to use the title on the particular class of goods involved, he may enjoin other uses in connection with those goods.

A sensible solution to the priority of use problem would be for courts to deny the existence of a secondary meaning in the plaintiff's title if a prior user, who could maintain an action against the plaintiff under the theories recognized in the particular jurisdiction, has acquired and continues to retain a secondary meaning through his own use of the title. At least one case, *Golenpaul v. Rosett*,⁶⁷ has indicated that such a view might be acceptable to the courts. In that case the defendant had published two issues of a radio and movie magazine titled *Information Please* in 1936, but at that time was forced to discontinue publication because of a lack of funds. In 1938 the plaintiff produced his highly successful radio series of the same name, used it as the title of a book and was in the process of making a movie under the same title. When, in 1939, the defendant was financially able to resume publication of his magazine, the plaintiff sought to enjoin his use of the name *Information Please* in connection with it. In granting the injunction the court inferred that it was not simply a prior use that gave one an exclusive right to a particular title, but rather it was the acquisition of a secondary meaning. If there was no secondary meaning, a party had the non-exclusive right to use the title. Under this postulation of the secondary meaning concept then, when the plaintiff began to use the name in connection with his radio program he was entitled to its non-exclusive use; but when the name became so associated with his program that it acquired a secondary meaning, he became entitled to its exclusive use, within the meaning of the law of unfair competition.⁶⁸ Thus, even if the defendant had used the name prior to the plaintiff, he could be enjoined from further use if he, the defendant, had failed to acquire and retain a secondary meaning.

66. *Estes v. Williams*, 21 Fed. 189 (C.C.S.D.N.Y. 1884).

67. 174 Misc. 114, 18 N.Y.S.2d 889 (Sup. Ct. 1940).

68. *Id.* at 116, 18 N.Y.S.2d at 893. This, of course, presumes that the law of the jurisdiction affords protection in the absence of direct competition, *i.e.*, that confusion of source or sponsorship or dilution is an accepted theory.

2. Fanciful Words

It is generally held that if a title is merely descriptive of the contents of the work to which it is attached it cannot acquire a secondary meaning.⁶⁹ Thus, for example, in the case of *McGraw-Hill Book Co. v. Random House, Inc.*,⁷⁰ it was held that the title *PT-109, John F. Kennedy in World War II* merely described what the reader was likely to find in the book, and hence was not entitled to protection under the law of unfair competition. The test is not whether a limited group would consider the title descriptive, but whether the general public would consider it so. Thus in deciding that the *Virgin Queen*, when applied to a play or movie about Queen Elizabeth I, was merely descriptive, it was stated that even the moderately educated would associate that particular title with that particular monarch.⁷¹ Where, however, the title is fanciful or arbitrary, conveying no message as to what the work's contents might be, it can acquire a secondary meaning.⁷²

3. Length of Time Used

There is no definable period of time a title can be used to assure its acquisition of a secondary meaning; such acquisition depends entirely upon the facts of each individual case.⁷³ The *Restatement of Torts* points out that "long continued use of the designation is evidence from which this 'secondary meaning' may properly be inferred: but the inference

69. *E.g.*, *Collins v. Metro-Goldwyn Pictures Corp.*, 25 F. Supp. 781, 784 (S.D.N.Y. 1938), *rev'd on other grounds*, 106 F.2d 83 (2d Cir. 1939) (*Test Pilot*); *Crown Publishers, Inc. v. David McKay Co.*, 200 Misc. 905, 906, 107 N.Y.S.2d 176, 177 (Sup. Ct. 1951) (*Confidential*). *Contra*, *Warner Bros. Pictures, Inc. v. Majestic Pictures Corp.*, 70 Fed. 310, 311 (2d Cir. 1934) (*The Gold Diggers*).

70. 32 Misc. 2d 704, 225 N.Y.S.2d 646 (Sup. Ct. 1962).

71. *Fishler v. Twentieth Century-Fox Film Corp.*, 159 F. Supp. 215, 217 (S.D. Cal. 1958). *But cf.* *Martenet v. United Artists Corp.*, 56 F. Supp. 639, 640 (S.D.N.Y. 1944), where the court held that the novelette title *Voice in the Wind* was merely descriptive in that it served to identify the work. As this is true of all titles, the test should be whether they describe the contents rather than whether it is the description people use when asking for the work. See also *In Re Cooper*, 45 C.C.P.A. (Patents) 923, 929, 254 F.2d 611, 615 (1958), where the court said, ". . . however arbitrary, novel or non-descriptive of the contents the name of a book—its title—may be, it nevertheless describes the book. . . ." The court, however, was deciding a trademark application case, and not a question of unfair competition.

72. *E.g.*, *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P.2d 474, 482 (Dist. Ct. App. 1947) (*Queen of the Flat Tops*); *Selig Polyscope Co. v. Unicorn Film Serv. Corp.*, 163 N.Y. Supp. 62 (Sup. Ct. 1917), *aff'd*, 183 App. Div. 882, 169 N.Y. Supp. 1113 (1918) (*The Rosary*); *Dickey v. Mutual Film Corp.*, 174 App. Div. 99, 160 N.Y. Supp. 609 (Sup. Ct. 1916) (*The Come-Back*); *Monro v. Beadle*, 55 Hun 312, 8 N.Y. Supp. 414, 415 (Sup. Ct. 1890) (*Old Sleuth*). See generally 3 CALLMAN, *op. cit. supra* note 53, § 83.2.

73. I NIMS, *op. cit. supra* note 60, § 38(a). See, *e.g.*, *Cal. Crushed Fruit Corp. v. Taylor Beverage & Candy Co.*, 38 F.2d 885 (W.D. Wis. 1930); *Sun Valley Mfg. Co. v. Sun Valley Togs, Inc.*, 39 F. Supp. 502 (S.D.N.Y. 1941); *Triangle Publications, Inc. v. Hanson*, 65 F. Supp. 952 (E.D. Mo. 1946), *aff'd*, 163 F.2d 74 (8th Cir. 1947).

is rebuttable."⁷⁴ Where, however, the work has not yet been released to the public, no secondary meaning is likely to have attached.⁷⁵

4. Extent of Use

Probably the most important single factor considered by courts in determining the secondary meaning question is the extent to which the plaintiff has used the title he has chosen for his work. *Hopkins Amusement Co. v. Frohman*⁷⁶ presents a clear example of how an extensive use of a title will result in a determination that a secondary meaning has attached to it. The plaintiff in that action had purchased the exclusive rights to dramatize the A. Conan Doyle and William Gillette story, *Sherlock Holmes*. An extensive advertising campaign was conducted prior to the performance of the plaintiff's play, it was presented in the major metropolitan areas of the country and eventually became a great success. The defendant was thereafter enjoined by the plaintiff from producing *Sherlock Holmes, Detective*, a "greatly inferior" play, in his Chicago theatre based upon an application of the confusion of product theory by the court.⁷⁷ The primary elements of the extensive use theory, as exemplified by the *Frohman* case, are: (a) the popularity of the plaintiff or the person from whom he purchased the work, (b) the extent of the plaintiff's advertising, (c) the geographical area of the use and (d) the success of the work to which the title is attached.

a. Popularity of plaintiff

Public acceptance of an author or composer may lead more readily to his work's acquisition of a secondary meaning than would be likely if the title's originator was a relative "unknown." When a famous author's book or play is released it may take but a single advertisement or news story—indeed a very short period of time—for the public to associate the new work and its title with him. While very few cases refer expressly

74. RESTATEMENT, TORTS § 716, comment *b* at 560 (1938). See also *Chancellor of Oxford Univ. v. Wilmore-Andrews Publishing Co.*, 101 Fed. 443 (C.C.S.D.N.Y. 1900), where the long use of the name *Oxford* in connection with bibles was stressed in enjoining the defendant's similar use of the name.

75. *E.g.*, *Walt Disney Prod., Inc. v. Souvaine Selective Pictures, Inc.*, 98 F. Supp. 774 (S.D.N.Y. 1951), where the plaintiff's movie *Alice in Wonderland* had not yet been released. The court apparently did not consider the extensive advance advertising as a "use," although there would seem to be no reason why a secondary meaning could not be acquired through advance publicity, as in the ill-fated attempt to produce *Tucker Torpedo* automobiles in the late 1940's. See also *Fishler v. Twentieth Century-Fox Film Corp.*, 159 F. Supp. 215, 217-18 (S.D. Cal. 1958) (unproduced play has no secondary meaning).

76. 202 Ill. 541, 542, 67 N.E. 391, 392 (1903).

77. *Id.* at 542-43, 67 N.E. at 393.

to this popularity concept,⁷⁸ it is one which should be kept in mind, particularly as it affects the length of use, the extent of advertising, etc., necessary to create the required association in the mind of the public between the title and its original user.⁷⁹

b. Advertising

An element frequently referred to by the courts in its search for secondary meaning is the extensiveness of the plaintiff's advertising in connection with his work.⁸⁰ The purpose of advertising is, of course, to cultivate a desire in the anticipated consumer class for the product advertised. In order to relate this created demand to a shortened description of the product, a title or name is employed in the advertising. It follows that the more advertisements the plaintiff has put before the public, the more the public is likely to mentally associate the title with the product or with the plaintiff.⁸¹

c. Geographical area

Generally, products of the entertainment field are intended for at

78. Compare *Collins v. Metro-Goldwyn Pictures Corp.*, 25 F. Supp. 781, 782 (S.D.N.Y. 1938), *rev'd on other grounds*, 106 F.2d 83 (2d Cir. 1939) (an unknown author), with *Manners v. Triangle Film Corp.*, 244 Fed. 293, 294 (S.D.N.Y.), *rev'd*, 247 Fed. 301 (2d Cir. 1917) (well-known playwright).

79. *But cf.* *Crown Publishers, Inc. v. David McKay Co.*, 200 Misc. 905, 907, 107 N.Y.S.2d 176, 177-78 (Sup. Ct. 1951), where the plaintiffs were well known for a series of exposés using the word *Confidential*, and the defendant, who had authored the allegedly unfairly competing book *Baseball Confidential*, had previously written the best-selling *The Jackie Robinson Story*. In denying the injunction, the court reasoned that those who purchase books do so as much because of the author's name as the book's title. Since the defendant's name was prominently displayed on the book and on the book jacket, there was little chance of confusion. *Accord*, *McGraw-Hill Book Co. v. Random House, Inc.*, 32 Misc. 2d 704, 705, 225 N.Y.S.2d 646, 649 (Sup. Ct. 1962), where the court pointed out that both authors had previously written best-sellers.

80. *E.g.*, *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934) (approximately \$500,000 spent in advertising); *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 124, 222 P.2d 433, 435 (1950) (about \$3,300 spent in advertising); *Selig Polyscope Co. v. Unicorn Film Serv. Corp.*, 163 N.Y. Supp. 62, 63 (Sup. Ct. 1917), *aff'd*, 183 App. Div. 882, 169 N.Y. Supp. 1113 (1918) (widely advertised).

81. *But cf.* *Walt Disney Prod., Inc. v. Souvaine Selective Picture, Inc.*, 98 F. Supp. 774 (S.D.N.Y. 1951), where the plaintiff had conducted an extensive advertising campaign for his movie *Alice in Wonderland*. In denying an injunction, the court indicated that no amount of advertising could create a secondary meaning if the product had not yet been released to the public. Apparently the court felt that even though the advertising had created the demand, that demand could not be associated to an unmarketed product. *Id.* at 776. The likelihood of the plaintiff not subsequently releasing the movie would appear minute, so the created demand was for a specific product of the plaintiff's. It's difficult to see why an extensively pre-advertised product such as this could have a secondary meaning the day after it is released, but not the day before. See also *McGraw-Hill Book Co. v. Random House, Inc.*, 32 Misc. 2d 704, 712, 225 N.Y.S.2d 646, 655 (Sup. Ct. 1962), where the court, in denying an injunction, indicated that the defendant had selected his title before the plaintiff's book had been released for sale. While this might be relevant if intent were required, it is difficult to see that it has any bearing on the plaintiff's acquisition of a secondary meaning.

least nationwide distribution. The plaintiff, in any action to contest the right of another to employ the same or similar title, will therefore attempt to assert and establish his exclusive right to use the title with relation to his product throughout the country.⁸² To be entitled to such extensive relief the weight of authority demands the plaintiff show that the general public in the area within which he seeks to exclude other users—*e.g.*, the nation—has grown to associate the title with either the plaintiff or his work.⁸³ Directly contrary to this position is the holding in *Jackson v. Universal Int'l Pictures, Inc.*⁸⁴ At trial the plaintiff, author of the play *Slightly Scandalous*, established that prior to the play's introduction two trade journals made reference to it, and very brief notices were also run in two Los Angeles newspapers. Further, it was shown that subsequent to Hollywood rehearsals the play ran for fifteen performances in Philadelphia, only attracting about 3,000 customers during that period, and then ran for only seven performances in New York City where it was played to a total of about 750 people. Customary advertising was employed in both communities during the short periods when the play was running, and critical reviews of the play appeared in the papers of these cities. More than two years after the play's final performance, the defendant made nationwide distribution of a movie with the same title. Not only did the defendant suffer an adverse judgment of \$17,500 on the basis of these facts, but he was also informed by the California Supreme Court that the number of people who would be likely to mentally associate the defendant's movie with his adversary's play was only relevant in determining the amount of his liability. As long as there were "more than a few" such persons the court declared, there could be a secondary meaning in the plaintiff's title.⁸⁵

Admitting that plaintiffs in unfair competition cases should not be saddled with the impossible task of having to prove to a court's satisfac-

82. However, names can acquire a secondary meaning in a particular geographical area. Nims asserts that this will depend primarily on the nature of the business. If it is a service or product that is usually sold in a single community, it can have a secondary meaning in that city. Thus, the Yellow Cab Company of Chicago, while entitled to the exclusive use of that name in Chicago, could not prevent its use in a distant city. I NIMS, *op. cit. supra* note 60, § 38, and cases cited therein.

83. See, *e.g.*, *Wyatt Earp Enterprises, Inc. v. Sackman, Inc.*, 157 F. Supp. 621 (S.D.N.Y. 1958) (network television series); *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934) (1,236 different stories nationally distributed); *Paramore v. Mack Sennett, Inc.*, 9 F.2d 66 (S.D. Cal. 1925) (numerous publications in national magazines); *Golenpaul v. Rosett*, 174 Misc. 114, 18 N.Y.S.2d 889 (Sup. Ct. 1940) (network radio program). See also *Becker v. Loew's, Inc.*, 133 F.2d 889 (7th Cir. 1943) (sale of only 700 books insufficient); *Manners v. Triangle Film Corp.*, 247 Fed. 301 (2d Cir. 1917) (production of play only in New York City insufficient).

84. 36 Cal. 2d 116, 222 P.2d 433 (1950).

85. *Id.* at 122, 222 P.2d at 437.

tion that a numerical majority associate the title with the plaintiff or his work, it seems impossible to retain the concept of necessary mental association by the general public if the *Jackson* case is taken at face value. The decision imputes the existence of a property right in the first user of the title in controversy who lets "more than a few" people know about it—a property right which absolutely excludes all future use of that same title by others. Perhaps this case points up more poignantly than any other the conflicting concepts of property right and monopolistic privilege.⁸⁶ The *Jackson* case, treating the interest involved as a property right, affords it the traditional broad protection extended to other property rights in our society. Those cases which treat it as a monopolistic privilege in an idea or language, on the other hand, seek to limit the protection afforded.

d. Success

Since, as seen above, courts require a widespread mental association by the general public of the title with the plaintiff or his work, the success or failure of the sales effort may be some indication of whether or not a secondary meaning has attached to his title. Where the work receives wide public approval a court is more likely to find that the requisite secondary meaning in the title has become established.⁸⁷ But, conversely, where the work is poorly received by the public courts frequently find that the product has acquired no secondary meaning.⁸⁸ Once again, standing in direct opposition to this position is *Jackson v. Universal Int'l Pictures, Inc.*⁸⁹

Popularity is not a requirement for secondary meaning be-

86. See Birrell, *Seven Lectures on the Law and History of Copyright in Books*, in KAPLAN & BROWN, *CASES ON COPYRIGHT, UNFAIR COMPETITION, AND OTHER TOPICS BEARING ON THE PROTECTION OF LITERARY, MUSICAL, AND ARTISTIC WORKS* 41 (1960). See generally Callman, *Unfair Competition in Ideas and Titles*, 42 CALIF. L. REV. 77 (1954); see, e.g., *High v. Trade Union Courier Publishing Corp.*, 69 N.Y.S.2d 526 (Sup. Ct. 1946), *aff'd*, 275 App. Div. 803, 89 N.Y.S.2d 527 (1949), where a court invoked its equitable powers to protect the disclosure of a tax exemption that was available under the Internal Revenue Code.

87. E.g., *Warner Bros. Pictures, Inc. v. Majestic Pictures Corp.*, 70 F.2d 310 (2d Cir. 1934) (very successful); *National Picture Theatres, Inc. v. Foundation Film Corp.*, 266 Fed. 208, 209 (2d Cir. 1920) (very popular); *Patten v. Superior Talking Pictures, Inc.*, 8 F. Supp. 196 (S.D.N.Y. 1934) (all America knows); *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P.2d 474, 483 (Dist. Ct. App. 1947) (considerable popularity); *Selig Polyscope Co. v. Unicorn Film Serv. Corp.*, 163 N.Y. Supp. 62, 63 (Sup. Ct. 1917), *aff'd*, 183 App. Div. 882, 169 N.Y. Supp. 1113 (1918) (marked acceptance by the public).

88. E.g., *Becker v. Loew's, Inc.*, 133 F.2d 889 (7th Cir. 1943) (700 books sold or given away); *Collins v. Metro-Goldwyn Pictures Corp.*, 25 F. Supp. 781, 784 (S.D.N.Y. 1938), *rev'd on other grounds*, 106 F.2d 83 (2d Cir. 1939) (few sales of a book).

89. 36 Cal. 2d 116, 122, 222 P.2d 433, 437 (1950).

cause notoriety and adverse discussion may bring about widespread identification of the play by its title and may pique the public interest. Likewise, advertising, even of an unpopular play, may cause the public to identify it as one which has been a "Broadway production."⁹⁰

While having the exclusive right to the title of a first-class flop might considerably decrease the amount of damages sustained by the plaintiff, the property right concept lends considerable credence to the notion that perhaps an author or composer should not be deprived of the only thing he can salvage—a widespread mental association that has advertising value. This would enable him to revise the work and still take advantage of its familiarity in order to make it a success, or at least give him the opportunity to sell it in the market for whatever it will bring. The monopoly concept, on the other hand, supports the view that only successful works contribute to society to such a degree as to entitle them to judicial protection.

These are the most important elements in establishing a secondary meaning. To be sure others may be gleaned from the cases, but they are usually stressed in isolated cases, and only because of the particular facts presented.⁹¹ The elements which have been briefly discussed above are those which have been repeatedly referred to by the courts regardless of factual divergencies between the cases presented them, and are likely to be those elements most seriously considered in future title duplication cases.

D. *Retention of Secondary Meaning*

If a secondary meaning is mental association it logically follows that a secondary meaning may not only be acquired, but it may also be lost. Since the doctrine of unfair competition proscribes interference by the defendant with the secondary meaning attached to the plaintiff's title, a showing by the former that whatever secondary meaning attributable at one time to the plaintiff's title has been lost will preclude recovery. A number of early cases, which fell without the entertainment title duplication field, established, if only briefly, that the defense of abandonment required a showing of an actual intent to abandon.⁹² But the *Restatement*

90. *Ibid.*

91. See, e.g., *Wall v. Rolls-Royce of America, Inc.*, 4 F.2d 333, 334 (3d Cir. 1925) (reliance by defendant's creditors); *Paramore v. Mack Sennett, Inc.*, 9 F.2d 66 (S.D. Cal. 1925) (plaintiff gave defendant notice of his prior use); *McGraw-Hill Book Co. v. Random House, Inc.*, 32 Misc. 2d 704, 711, 225 N.Y.S.2d 646, 656 (Sup. Ct. 1962) (price of plaintiff's book substantially higher than price of defendant's book).

92. E.g., *Saxlehner v. Eisner*, 179 U.S. 19, 31 (1900); *Andrew Jergens Co. v. Woodbury, Inc.*, 273 Fed. 952, 960 (D. Del. 1921), *aff'd* 279 Fed. 1016 (3d Cir. 1922).

of *Torts* has modified this absolute requirement of intent and bases abandonment on: (1) non-use coupled with (a) an intent to abandon and actual loss of the secondary meaning, or (b) the acquisition of a secondary meaning by another user, or (2) non-use coupled with a withdrawal from the business in which the name has formerly been used.⁹³

The title duplication cases, while never having discussed the question of secondary meaning retention at great length, probably have established an even more liberal test of abandonment than that set forth in the *Restatement*. In title duplication cases, as in all others, courts will consistently find a loss of secondary meaning, and hence deny recovery, where there is a non-use, an intent to abandon and a loss of the mental association of the title with its originator in the mind of the public.⁹⁴ The extension, however, is to be found in those cases involving a non-use, without an intent to abandon, coupled with a loss of the mental association. The *Restatement* position would require another to have acquired an intervening secondary meaning, but the better reasoned title duplication cases view as relevant only the effect of the plaintiff's non-use upon his own title.⁹⁵ Of course the defense of abandonment raises a question of "fact to be determined by the jury on substantial evidence."⁹⁶

III. FUTURE DEVELOPMENTS

The law in title duplication cases has passed the point where one need ask whether protection should ever be afforded. The answer from *Jollie v. Jaques*⁹⁷ to *McGraw-Hill Book Co. v. Random House, Inc.*⁹⁸ has been a resounding yes! The principal area of uncertainty is, rather, how much protection shall be afforded and by what means.

One group of authors feels that it is time to apply revolutionary new concepts to the title duplication cases.⁹⁹ While the means they would employ are not identical, the end result would be similar. Typical of this

93. *RESTATEMENT, TORTS* § 752 (1938).

94. *Golenpaul v. Rosett*, 174 Misc. 114, 117, 18 N.Y.S.2d 889, 893 (Sup. Ct. 1940).

95. See, e.g., *Int'l Film Serv. Co. v. Associated Producers, Inc.*, 273 Fed. 585, 587 (S.D.N.Y. 1921) (15 years non-use); *Goldman v. R.K.O. Pictures, Inc.*, 149 Misc. 226, 267 N.Y. Supp. 28, 29 (Sup. Ct. 1931) (13 years non-use); *Screen Test, Inc. v. American Broadcasting Co.*, 277 App. Div. 755, 97 N.Y.S.2d 372 (3½ years non-use). But cf. *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 124, 222 P.2d 433, 438 (1950) (retained after 3 years non-use because of practice of selling titles to movie companies); *Saland v. Monogram Pictures Corp.*, 67 N.Y.S.2d 436, 438 (Sup. Ct. 1946) (retained after 10 years non-use because of movie reissue value).

96. *Jackson v. Universal Int'l Pictures, Inc.*, 36 Cal. 2d 116, 123, 222 P.2d 433, 438 (1950).

97. 13 Fed. Cas. 910 (No. 7437) (C.C.S.D.N.Y. 1850).

98. 32 Misc. 2d 704, 225 N.Y.S.2d 646 (Sup. Ct. 1962).

99. See, e.g., 3 *CALLMAN, op. cit. supra* note 53, at 1592; O'Brien, *The Travails of a Federal Law of Unfair Competition*, 15 *BUS. LAW.* 279 (1960).

group are those proposing the extension of the copyright law. As has been seen, the *Jollie* case conclusively determined that the copyright law does not, as then and now constituted, extend its protection to the titles themselves. It did not, however, declare that Congress was powerless to effectuate such an extension by appropriate legislation and it has been proposed to amend the copyright law so as to permit the separate registration of titles having specified characteristics.¹⁰⁰ While adoption of such a proposal would eliminate the fragmentation of the law, thereby promoting the development of a comprehensive and uniform body of federal law, it represents a radical step on the road to infusing all literary work with the characteristics of a property right. Such a result undoubtedly has much merit in the eyes of those associated with the entertainment field, but the political climate and traditional opposition to monopoly grants would not appear conducive to the successful achievement of such a major step and "it may be safely concluded that no such amendment will be forthcoming in this country."¹⁰¹

A second group of writers seem to favor the process of evolution—the process by which courts would continue to re-define the "plastic" law of unfair competition to meet the changing needs of society. The suggested speed with which this evolution is to and should take place varies with the temperament of the particular writer. On the one hand it is said that "instead of either standing pat or rushing blindly into a great unmapped territory, the courts can feel their way cautiously . . . [to] . . . block out a few new kinds of standardized wrongs."¹⁰² Another and more rapid process was envisioned when it was said that "the law and the judge's sense of fairness should go hand in hand and . . . any decision which does violence to the judge's own sense of fairness must stand on shaky ground. . . ."¹⁰³

The history of the law in the title duplication area indicates that those favoring the gradual development of the doctrine of unfair competition will find their view accepted. The speed of this process will continue to depend on the temperament and economic predilections of those who are charged with deciding the cases, individually and as a group. The most likely area of evolution presently appears to be toward the widespread acceptance of the dilution theory, but at least one predic-

100. Klein, *Is Unauthorized Use of Titles of Artistic Works in Unrelated Fields Actionable Piracy*, 28 BROOKLYN L. REV. 59, 84-87 (1961). *Contra*, WARNER, RADIO AND TELEVISION RIGHTS § 243(a) (1953).

101. Netterville & Hirsch, *Piracy and Privilege in Literary Titles*, 32 SO. CAL. L. REV. 101, 111 (1959).

102. Chafee, *Unfair Competition*, 53 HARV. L. REV. 1289, 1315 (1940).

103. Derenberg, *Copyright No-Man's Land: Fringe Rights in Literary and Artistic Property*, 35 J. PAT. OFF. SOC'Y 770, 783 (1953).

tion can be made without qualification: Those who advocate containing the law of title duplication within its present boundaries are running counter to the stream of history. As the court stated in the *Johnston* case:¹⁰⁴

Property rights exist because they promote the general welfare. As society has developed there has been a corresponding evolution in the development of property rights. Matters considered as near revolutionary a few short years ago are now accepted as facts. Legal history shows a continual recognition of new interests and a gradual willingness to protect interests in intangible things.

When the market place says that entertainment titles have monetary value and must be effectively protected, can the courts be far behind?

THE RIGHT TO COUNSEL IN FEDERAL COURTS AND THE PROPOSED AMENDMENTS TO THE FEDERAL RULES OF CRIMINAL PROCEDURE

The general public, legal writers and the courts long have recognized the inequities of the law in its treatment of the indigent criminal defendant. For many years legal assistance has been provided to the indigent in some areas of the United States through private legal aid societies, yet this activity has been restricted almost entirely to civil litigation.¹ In those few areas where there has been private legal assistance for the indigent criminal defendant, a lack of funds and the sheer volume of cases has limited the scope of these programs.² For these reasons the burden of protecting the indigent in a criminal prosecution has been upon the courts.

In early decisions little consideration was given to the plight of the indigent although prosecuted under a judicial system which relies heavily upon the adversary system to protect individual rights. After 1900, however, increasing recognition was given to the importance of counsel

104. *Johnston v. Twentieth Century-Fox Film Corp.*, 82 Cal. App. 2d 796, 187 P.2d 474, 487 (Dist. Ct. App. 1947).

1. "[O]f the 200 legal aid offices in existence by mid-1958, only six handle criminal cases." SPECIAL COMM. TO STUDY DEFENDER SYSTEM, ASS'N OF THE BAR OF THE CITY OF N.Y., EQUAL JUSTICE FOR THE ACCUSED, 42-44 (1959).

2. *Id.* at 69, 71-72.